

REMARKS

In a final office action mailed on July 27, 2005, each of independent claims 1, 10 and 19 was rejected under §103(a) over EP 905879 (to Herzinger et al.) in view of U.S. Patent No. 6,208,975 (to Damgaard et al.). The remaining claims were rejected under §103(a) over Herzinger et al., Damgaard et al. and U.S. Patent No. 5,130,670 (to Jaffe).

Applicant filed a Notice of Appeal and a Pre-Appeal Brief Request for Review on September 29, 2005, and a Notice of Panel Decision was mailed on November 14, 2005 reopening prosecution.

In the office action mailed on January 26, 2006, each of independent claims 1, 10 and 19 was rejected under §102(a) over Herzinger et al., and the remaining claims were rejected under Herzinger et al. and/or Damgaard et al. and/or Jaffe under §102(a) or §103(a).

The recent office action asserts that the circuit of Herzinger et al. is capable of operating in two modes of operation where in a second mode the difference $F_{VCO} - F_{LO}$ is used instead of $F_{LO} - F_{VCO}$ resulting in $F_{LO} = F_{OUT} / (1 - m/n)$. There is, however, no disclosure of such a dual mode operation in the Herzinger et al. reference. Rather, the office action asserts that circuits of the Herzinger et al. reference have the same elements as claimed by applicant, and *could* therefore be employed to provide a dual frequency circuit having the specific frequency plans recited in claims 1, 10 and 19 if used in a dual band operation. The office action recognizes, however, that the Herzinger et al. reference does not disclose that either of the frequency dividers in Herzinger et al. are provided such that the translation loop modulator operates in a second mode where $F_{LO} = F_{OUT} / (1 + m/n)$. In effect, the office action asserts that the features of the independent claims are inherent in the Herzinger et al. reference.

To establish inherency, the extrinsic evidence “must make clear that the missing

descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q.2D 1746, 1749 (Fed. Cir. 1991) (*emphasis added*). “Inherency however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* 948 F.2d at 1269, 20 U.S.P.Q.2D at 1749, *quoting*, In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). The court in In re Oelich also interpreted functional language as limiting when it forms part of a means plus function clause. 666 F.2d at 581.

Moreover, in a Section 132 Declaration of Robert Broughton, filed on May 24, 2004 (a copy of which is again enclosed), the applicant submitted that the Herzinger et al. reference does not disclose a dual band radio frequency transmitting system that provides a first frequency divider unit for providing a divide by m function and a second frequency divider unit for providing a divide by n function such that $F_{LO} = F_{OUT} / (1 + m/n)$ in a first mode of operation and $F_{LO} = F_{OUT} / (1 - m/n)$ in a second mode of operation. (Broughton Declaration, ¶6). The §132 Declaration of Robert Broughton clearly, therefore, supports applicant’s position that such operation is not inherent in the Herzinger et al. reference as the features at issue would not be recognized as being present in the Herzinger et al. reference to one of ordinary skill in the art.

Claim 1 requires, in part, comparator means that includes a first frequency divider unit for providing a divide by m function and a second frequency divider unit for providing a divide by n function such that $F_{LO} = F_{OUT} / (1 + m/n)$ in said first mode of operation and $F_{LO} = F_{OUT} / (1 - m/n)$ in said second mode of operation. Claims 10 and 19 each require, in part, an oscillator means for producing an output transmission signal responsive to said phase comparator signal, said output transmission signal having a frequency F_{OUT} wherein $F_{LO} = F_{OUT} / (1 + m/n)$ in said

first mode of operation and $F_{LO} = F_{OUT} / (1 - m/n)$ in said second mode of operation. Each of claims 1, 10 and 19, therefore, is submitted to be in condition for allowance. Each of claims 2, 3, 5, 7 - 9, 11, 12, 14, 16 - 18 and 20 - 22 depends either directly or indirectly from one of claims 1, 10 or 19, and is also submitted to be in condition for allowance.

Each of claims 1 - 3, 5, 7 - 12, 14 and 16 - 22, therefore, is in condition for allowance.

Favorable action consistent with the above is respectfully requested.

Respectfully submitted,



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